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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,140	12/06/2001	Jan Eirik Ellingsen	0104-0527PUS1	4761
2292	7590	03/06/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			ISABELLA, DAVID J	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/010,140	ELLINGSEN ET AL.	
	Examiner	Art Unit	
	DAVID J. ISABELLA	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-17,41 and 42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-17,41 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

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Attachment(s)

- | | |
|---|--|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/4/06</u></p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____</p> |
|---|--|

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Status of the Claims

Currently, claims 1-7,9-17, 41 and 42 are pending. Claims 8 and 18-40 have been cancelled.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4,6,9,41 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Bjursten et al (5152993).

Bjursten et al. discloses a medical prosthetic device (col 1, lines 20-24 for example) comprising a metal material having a surface; wherein the metal material consisting of titanium (col 1 lines 18-20) the surface of the metal material comprises a layer of a corresponding hydroxide material consisting of titanium hydroxide (col 2, lines 18-32) wherein the layer of hydroxide material comprises one or more biomolecule substances associated therewith (peroxide and biomolecules, col 2, lines 55-59). The biomolecule substance consists natural extracellular matrix proteins, recombinant extracellular matrix proteins; natural extracellular matrix bio-molecules amino acids; fatty acids, (col 2, lines 33-35), and biologically active anions (peroxide). The biomolecule

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substance is present on the surface of the hydroxide material and/or present as an inclusion compound a trapped in the hydroxide material (Col. 2, lines 55-62).

Claim 6, see column 3, lines 15+.

Claim 9, see column 1, lines 18-20.

Claim 41, see column 2, lines 33-35.

Claim 42, see rejection to claim 1 supra.

Claim Rejections - 35 USC § 103

Claim 5,7,10-17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bjursten et al (5152993).

Claim 5, applicant has not disclosed that having concentrations in an amount of about 1.0 picogram to 1 millogram per square mm solves any stated problem or is for any particular purpose. Moreover, it appears that the device would before equally well with concentrations in an amount of about 1.0 picogram to 1 millogram per square mm with a biomolecule such as an amino acid (protein). Accordingly, if not inherent in Bjursten et al, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated concentrations in an amount of about 1.0 picogram to 1 millogram per square mm of an amino acid into the hydroxide coating of Bjursten et al because such a modification would have been considered mere design consideration which fails to patentably distinguish over the prior art of Bjursten et al.

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Claims 7,11-17, Bjursten et al disclosure is generic to coating any titanium implant so, Bjursten et al remains silent as to the specific use in implants selected from the group consisting of a femoral hip joint, a femoral head; an acetabular cup, an elbow, a knee, a shoulder, a wrist, a ankle, a hand, a finger, a toe, a vertebra, a spinal disc, a cochlea, a heart valve, and a vessel. It is well known in the art of vessel implants, orthopedic implants and heart valves to be made of titanium for the purpose of being biocompatible. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make implants any implant with biocompatibility to facilitate new tissue formation adjacent the implant surface to ensure long term success.

Claim 10, see rejection to claim 5 supra.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J. ISABELLA whose telephone number is 571-272-4749. The examiner can normally be reached on MONDAY-FRIDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CORRINE MCDERMOTT can be reached on 571-272-4754. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DAVID J ISABELLA
Primary Examiner
Art Unit 3738

DJJI
3/2/2006

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